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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,949	06/21/2001	Isabelle Afriat	209060US	2772
22850	7590	10/23/2003		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WELLS, LAUREN Q	
			ART UNIT	PAPER NUMBER
			1617	
			DATE MAILED: 10/23/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,949

Applicant(s)

AFRIAT, ISABELLE

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-29 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/11/03 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. (5,851,539).

The instant invention is directed to a water-in-oil emulsion comprising an aqueous phase dispersed in an oily phase with the aid of a silicone emulsifier, wherein the aqueous phase comprises 80% of the emulsion, the oil phase and emulsifier are present in a weight ratio of greater than or equal to 5, and the emulsifier is a dimethicone copolyol comprising only oxyethylene groups as oxyalkylene groups, and methods of applying this emulsion to the skin.

Mellul is directed to water-in-oil emulsions that contain fluorocarbon oils, water and a silicone surfactant (title and abstract). Example 24 at col. 15 comprises 2.5 wt.%

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polyoxyethylenated dimethicone copolyol (KF 6017), 25 wt.% fluorohydrocarbon oil and 70 wt.% water. In this composition, the weight ratio of oily phase (fluorohydrocarbon) to emulsifier is 10. At col. 7, lines 49-52, Mellul teaches that the aqueous phase makes up 10-90wt.% of the emulsion. Mellul teaches application of the emulsion to the skin at col. 10, lines 31-48. For polyols such as propylene glycol and glycerol see col. 7, lines 53-56. For electrolytes such as sodium chloride see col. 8, line 6. For volatile silicone oils see Col. 7, lines 15 and following. Col. 10, lines 16-21 teach that it is possible to obtain emulsions of very different viscosity ranging from very fluid to the solid state by varying the percentage of aqueous phase and/or by choosing the gelling or structuring constituents in each of the phases.

Viscosity is an inherent property that is not given patentable weight. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. Because the composition of Mellul contains the same components in the same amounts as instantly claimed, burden is shifted to Applicant to show that the prior art product does not inherently possess the instantly claimed viscosity.

Mellul does not exemplify at least 80 wt% aqueous phase in the emulsions or explicitly teach application of the composition to the greasy skin. Mellul teaches, as stated above that the emulsions can contain up to 90 wt.% water. Mellul discloses that the emulsions are useful in cosmetics and dermatology for the treatment of skin.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the emulsions of Mellul containing at least 80 wt.% water and apply the

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emulsion to greasy skin because of the expectation of preventing transepidermal water loss and protecting the skin from external damage, and because of the expectation of applying a cosmetic product that does not further promote greasy skin, see Col. 1, lines 25-29.

Claims 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. as applied to claims 1-22 and 25-29 above, and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Co., New York, NY, 1981, page 423.

Mellul et al. is applied as discussed above. The reference lacks ethanol.

Hawley teaches that ethanol is a common ingredient in cosmetics and acts as a solvent for fats and oils.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add ethanol, as taught by Hawley, to the compositions of Mellul et al. because of its solvent properties.

Response to Arguments and Declaration

Applicant argues, "Chevalier's July 24, 2002 declaration demonstrates that compositions containing aqueous phases of 80.5% (example), 79.83% (CM 3/1) and 86.55% (CM 3/2) readily break. Moreover, . . . Chevalier reports that W/O emulsions containing aqueous phases of 89.5% and 90.55% readily break as well". This argument is not persuasive. First, regarding the declaration filed 8/18/03, there is not data that shows that 658462-2 and 658463-3 readily break when a shear stress is applied. Second, it is respectfully pointed out that Example 1 of the July 24, 2002 declaration, provides no data showing that the emulsion readily breaks when a shear

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stress is applied. Furthermore, the graph of CM 3/1, is contrary to Applicant's arguments, as this emulsion does not "readily break" under shear stress, as depicted by the graph.

Applicant argues, "In addition to having improved rheological properties, the claimed compositions, despite their high water content, are stable even when stored under conditions of fluctuating temperatures" and "the examples in the present specification demonstrate the compositions containing the claimed silicone surfactant are more stable under fluctuating temperature conditions than compositions containing other silicone surfactants". This argument is not persuasive, as Applicant has provided no data that this property is unexpected.

Furthermore, it is respectfully pointed out that Col. 10, lines 6-10 of Mellul et al. states, that "The emulsions thus obtained are stable for several months within a broad range of temperatures of between -4C and 45 C, and they withstand the test of centrifugation of 4000 rpm for one hour.

Applicant argues, "The declarations also demonstrate that compositions corresponding to Mellul's Example 24 are unsuitable for use in the cosmetic industry". This argument is not persuasive. The Examiner respectfully points out that the July 24, 2002 declaration does not accurately depict Example 24 of Mellul et al. It is respectfully pointed out that the CM 3/5, 3/3, and 3/4 do not depict Example 24 of Mellul et al, as additional ingredients have been added and some ingredients of Example 24 have been deleted.

Regarding the declaration filed 7/24/02, it is not persuasive because a) none of the Examples of Mellul et al. are truly exemplified, as ingredients have been added and taken from the examples of Mellul et al.; b) the graph depicting the "breaking" property of CM 3/5 only depicts a sheer stress of 10-100Pa and the graph depicting the "breaking" property of CM 3/2 exhibits no breaking in the range of 10-100PA, but only breaks at sheer stresses of 350 and 375

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Pa, thus is it not possible to ascertain whether or not CM 3/5 has a “breaking” property at sheer stresses greater than 100Pa.; c) it is not known what composition “P5” represents in the graph on the second to last page of the declaration; d) the graph of CM 3/1, which is one of the inventive compositions, exhibits no “breaking” properties.

Regarding the declaration filed 8/18/03, it is not persuasive because a) it is not possible to compare compositions 658462-2 and 658463-3 with the previous declaration, as there are no graphs, so it is not possible to evaluate the “breaking” property or the sheer stress applied.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw


SREENI PADMANABHAN
PRIMARY EXAMINER 9/5/03